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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,272	01/31/2002	Jeffrey H. Diamond	0136.0018C	7838

7590 11/06/2003

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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/059,272

Applicant(s)
JEFFREY H. DIAMOND

Examiner
YVONNE M. HORTON

Art Unit
3635



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 7, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-29 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, and 15 is/are rejected.
- 7) ☒ Claim(s) 5 and 14 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 31, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1 AND 2 6) ☐ Other:

Art Unit: 3635

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of species E as shown in Figures 17-20 in Paper No. 7 is acknowledged.

Regarding the applicant's suggestion that species D and H should be combined, although these two species are very similar, species D is very much different from species H in that species D is a preformed panel and species H is a patch. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,3,4,6-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #4,889,754 to VARGAS. VARGAS discloses a stabilized window structure including a window frame (FR) circumscribing an opening (OP) being entirely or substantially entirely devoid of glass, column 2, lines 21-24, to present a sizable hole (unlabeled), a removable patch (10), and a body of unifying material (16) to form a cohesive mass with the patch (10), see the

Art Unit: 3635

marked attachment. Regarding claim 3, the patch (10) includes a plurality of patch member adjacent one another and having a seam (21) formed therebetween. In reference to claim 4 and 6, the patch (10) has an adhesive backing (16) and is adhesively secured to the window, see figures 3-6. Regarding claim 7, the adhesive (16) is the unifying material and is disposed between the frame (FR) and the patch (10). In reference to claim 8, inherently the unifying material (16) is disposed in contact with any remaining glass especially because VARGAS does not detail removing any of the glass. Regarding claim 9, the patch (10) includes a release element (14), column 4, line 47, disposed between the frame (FR) and the adhesive (16). In reference to claims 10,11 and 15, the unifying adhesive (16) is a polymeric material, column 4, line 62. Although not explicitly detailed, it is inherent that the adhesive is a foam because it is pressure sensitive and pressure sensitive adhesives are foamed adhesives. Regarding claim 12, the unifying adhesive (16) covers an exterior side of the window.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3635

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,889,754 to VARGAS. VARGAS discloses the basic claimed window structure except for the patch being a plurality of overlapping patches. In regards to the patch of VARGAS not being a plurality, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the patch of VARGAS as a plurality of separate patches because it is commonly known that constructing a formerly integral structure in various elements involves only routine skill in the art. In reference to the patches overlapping, it too would have been obvious to one having ordinary skill in the art at the time the invention was made to overlap the patches in order to ensure that the window is kept water and air tight until the window can be properly replaced.

Allowable Subject Matter

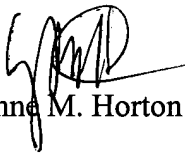
7. Claims 5 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. Claims 16-29 are allowed.
9. The following is a statement of reasons for the indication of allowable subject matter:

Art Unit: 3635

In reference to claims 5 and 14, the prior art of record fails to teach the use of a stabilized window using a patch member and unifying material wherein the patch includes a mechanical securing device or a grasping member.

Regarding claims 16-24, the prior art of record fails to teach the method of stabilizing a window including applying an adhesive after securing the patch in place.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909.

A handwritten signature in black ink, appearing to read 'YMH', is written over the printed name 'Yvonne M. Horton'.

Yvonne M. Horton

Primary Examiner

November 3, 2003

